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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,033	06/27/2002	Cristina Alonso-Alija	Le A 33 844	9908

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EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,033

Applicant(s)

ALONSO-ALIJA ET AL.

Examiner

Fiona T. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 20, 22, 23 and 25 to 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-19 and 21 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the amendment filed January 15, 2004, which has been entered in the file.

Applicant's election of Group IX, claims 3 to 19 and 21 and a method of treating hypertension (claim 24) in the amendment filed January 15, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 5, 7, 11 to 13 and 17 to 19 that were withdrawn in the previous Office action will be examined.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3 to 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosentreter et al. (US 5041638), of record.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses structurally similar compounds and compositions thereof which are useful as leucotriene disease

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antagonists. The compounds of the reference are structurally similar to the claimed compounds of the formula (I) wherein W is CH=CH and is ortho to the radical which contains V, T and V are O, R¹, R², and R³ are hydrogen, m is 1, n is 3, 4 or 5, Y is CH₂, A and B are COOH or COOCH₃, X is absent or S, r is 1 and o is 2, 3 or 4 or compounds of the formula (I) where W is CH₂CH=CH and is meta to the radical which contains V, T and V are independently absent or O, R¹ is hydrogen or F, R² and R³ are hydrogen, m is 1, n is 3, 4 or 5, Y is CH₂, A and B are COOH, COOCH₃ or COOCH₂CH₃, X is absent or S, r is 1 and o is 2, 3 or 4. Note Examples 67, 68, 77, 78, 103-106, 131-134, 143 and 144.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of the reference differ from those claimed in that they are homologs. For example, in the compounds of Examples 103-106, n is 4 in the compounds of the reference instead of 3 or 5 or o is 4 in the compounds of the reference instead of 5. In the compounds of Examples 131 and 132, n is 5 in the compounds of the reference instead of 6 or o is 4 instead of 3 or 5. It has been held that homologs are obvious over one another.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

Due to their close structural similarity one of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that compounds with similar properties would be obtained. The claimed compounds and compositions would have been rendered obvious by the structurally similar compounds of the reference in the absence of any unobvious property.

Applicant's arguments filed January 15, 2004 have been fully considered and are rendered moot since the rejections based on the generic disclosure of the reference and Examples 113 and 114 have been withdrawn.

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is (571)272-0702. The examiner can normally be reached on Monday - Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be

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reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
April 1, 2004